

DOCKET NO.: 4204.7-1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: John D. Schellenberg
 Application No.: 08/756,257
 Filed: 11/25/1996
 Examiner: Ruth S. Smith
 Group No.: 3737
 For: Tool Position Indicator

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| <i>Jacqueline Butler</i> | Jacqueline E. Butler |
| <u>3/28/2003</u> | Date |

#33

BOX NON-FEE AMENDMENT
 Director of the United States
 Patent and Trademark Office
 Washington, D.C. 20231

RESPONSE

Dear Sir:

This is in response to the Office action dated October 28, 2002.

Thank you for allowing claims 1, 7-13, 15, 22, 26, 29 and 31.

The rejection of the remaining claims pending in the application, namely claims 6 and 36-41 is respectfully traversed. The Examiner states that these claims are anticipated by Palestrant. In order for Palestrant to anticipate a claim, each and every element of the claim must be found in Palestrant. However, this is not the case.

Palestrant discloses a simple guide or "guidance device" that sets a biopsy needle or catheter at a "desired angle" set by a surgeon or doctor based on a section of a CT scan. A bubble level 34 indicates whether the base of guidance device (as opposed to an adjustable "arm" that

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holds the biopsy needle) is level. Neither the CT scanner nor the guidance device tracks the position of a surgical tool.

Claim 6 requires "means for determining an actual position of the means for indicating." Palestrant discloses no capability of determining an actual position of the bubble level, which presumably is what the Examiner contends is a "means for indicating." Therefore rejection of claim 6 under section 102(b) is in error.

Independent claims 36 and 37 each require "means for determining a position" of a surgical tool. Independent claim 41 requires a "tool position tracker." It is submitted that Palestrant does not possess any structure for performing the function of determining or tracking the position of a tool, and therefore cannot anticipate these claims or claims depending from them. Consequently, rejection of these claims under section 102(b), as well as dependent claim 38, is also in error.

Independent claim 39 and, by dependency, claim 40 require "tracking a surgical tool with reference to a patient's anatomy." Again, Palestrant's guidance device, alone or in combination with a CT scanner, does not track a surgical tool with reference to a patient's body. Thus, Palestrant cannot anticipate claims 39 and 40. Their rejection is in error.

The outstanding rejection should be withdrawn for these reasons and the application allowed. Such action is respectfully requested. The Examiner should feel free to telephone the undersigned representative to resolve any outstanding issues.


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Enclosed is a Petition for a Two-Month Extension of Time and fee in the amount of \$205.00. The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication to Deposit Account No. 13-4900 of Munsch Hardt Kopf & Harr, P.C.

Respectfully submitted,

Date: 3-28-2003
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March 28, 2003

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From: Marc A. Hubbard

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Application No. 08/756.257

Filing Date: 11/25/1996

Group Art Unit: 3737

Inventor: John D. Schellenberg

Title: Tool Position Indicator

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